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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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Paper No. 16  
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Wolford Aktiengesellschaft**

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Serial No. 75/**477,297**

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**Karl Hormann** of the Law Offices of Karl Hormann for **Wolford Aktiengesellschaft**.

**Michael W. Baird**, Trademark Examining Attorney, Law Office 109  
(Ronald R. Sussman, Managing Attorney).

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Before **Seeherman, Hohein and Chapman**, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

**Wolford Aktiengesellschaft** has filed an application to register the mark "FATAL," in the stylized manner shown below,

for "articles of clothing, namely, ladies' underwear and hosiery."<sup>1</sup>

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<sup>1</sup> Ser. No. 75/477,297, filed on April 30, 1998, which is based on an allegation of a bona fide intention to use the mark in commerce and a claim of ownership of Austrian Reg. No. 160,227.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "NEAR FATAL," which is registered for "clothing, namely, T-shirts, sweatshirts, jerseys, hats and shorts,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.<sup>3</sup>

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), "in any likelihood of confusion analysis[,] two key considerations are the similarity of the goods and the similarity of the marks."<sup>4</sup>

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<sup>2</sup> Reg. No. 2,205,162, issued on November 24, 1998, which sets forth a date of first use anywhere of May 20, 1997 and a date of first use in commerce of June 6, 1997.

<sup>3</sup> Inasmuch as Section 2(d), inter alia, prohibits registration of "a mark which so resembles a mark registered in the Patent and Trademark Office," applicant's unsubstantiated assertion that it has priority of use over registrant's claimed date of first use in commerce because "its stylized word mark 'FATAL' ... has been in continued commercial use in the United States since 1996" is irrelevant. See, e.g. In re Calgon Corp., 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971) [priority of use is not germane to an applicant's right to register in an *ex parte* proceeding].

<sup>4</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Turning first to consideration of the respective goods, applicant argues that it "caters exclusively to an upscale market and to this end maintains retail shops [for its goods] in such places as Madison Avenue in New York City and Rodeo Drive in Beverly Hills, California, among many other sites known for their exclusivity." By contrast, applicant asserts that the cited registration "covers significantly different goods ... of a kind not likely seen by that section of the consuming public which prefers not to shop in the kind of establishments where such goods are ordinarily sold."

The Examining Attorney, however, correctly points out that it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the goods in the application at issue and in the cited registration are broadly described as to their nature and type and, as is the case herein, there are no restrictions in the respective identifications of goods as to their channels of trade or classes of customers, it is presumed in each instance that the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for such

goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

No weight, therefore, may be given to applicant's contention that its ladies' underwear and hosiery are sold in different channels of trade than registrant's T-shirts, sweatshirts, jerseys, hats and shorts. Instead, as pointed out by the Examining Attorney, applicant's and registrant's goods must be considered suitable for sale in the same channels of trade, such as retail clothing shops and department stores, and that the same classes of purchasers, including women, shop for such items of apparel.

Furthermore, while applicant's goods are specifically different from registrant's goods, it is well established that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient, instead, that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, we agree with the Examining Attorney that the various third-party registrations which were

made of record with the final refusal are sufficient to establish that applicant's goods, while specifically different from registrant's goods, are nevertheless so closely related thereto that, if sold under the same or similar marks, a likelihood of confusion as to the origin or affiliation of the respective goods would result. In this regard, the Examining Attorney has introduced in support of his position copies of ten use-based third-party registrations of marks which, in each instance, are registered for one or more of registrant's goods, on the one hand, and one or both of applicant's goods on the other. Although the third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

In addition, with the final refusal, the Examining Attorney has made of record pages from several catalog excerpts "demonstrating that the goods in question are often sold through the same retail channels, and that purchasers are accustomed to seeing the goods sold together." In light of the above evidence, as well as the previously noted lack of any restrictions or limitations in the identifications of both applicant's and registrant's goods, we concur with the Examining Attorney that "[b]ecause the goods in question ... consist of items of apparel,

target the same consumers, and travel through the same channels of trade, they must be considered closely related." The marketing thereof under the same or substantially similar marks would accordingly be likely to cause confusion.

Turning, therefore, to consideration of the respective marks, applicant argues that there are "obvious physical, visual and phonetic differences, as well as differences in perception, between the two marks."<sup>5</sup> According to applicant:

The Examining Attorney has said, in effect, that a single blue line, for instance is confusingly similar to a compound yellow and blue line. Plainly, there is ... certainly no confusing similarity between such lines. One is tempted to invoke other analogies of striking dissimilarity between the two marks, such as, for instance, a fatal accident and a near fatal accident. If instead of FATAL, Appellant's mark had been "1" and the

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<sup>5</sup> Applicant also contends, among other things, that:

Appellant had previously applied for registration of its instant mark on the principal register by an intent-to-use application filed 8 February 1996 under Serial No. 75/055,426. That application was allowed over the mark "FATAL ATTRACTION" (Registration No.: 1600755), on 19 August 1997 in view of the *prima facie* dissimilarity between the two marks .... However, because of an unfortunate chain of events, Appellant's Allegation of Use was not timely filed, and the application thus became abandoned.

However, as the Examining Attorney, citing *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 639 (TTAB 1984), notes in his brief in response, "previous decisions of examiners allowing other marks are without evidentiary value and are not binding upon the [United States] Patent and Trademark Office or the ... Board" since each case "must be decided on its own merits." More importantly, we observe that the registration cited herein as a bar under Section 2(d) would not have likewise served, in light of the conflicting marks provisions of Trademark Rule 2.83(a), as a bar to applicant's previous application inasmuch as the June 9, 1997 filing date of the underlying application for such registration is obviously subsequent to the filing date which applicant alleges for its previous application. Thus, there has been no inconsistency in the ultimate treatment of applicant's previous application and its current application insofar as the statutory bar of Section 2(d) is concerned.

opposing mark were "21", their dissimilarity would also have to go unquestioned.

However, as the Examining Attorney persuasively points out:

[I]n the case at hand, the marks contain neither lines nor numbers. The analogies are simply inappropriate. Likewise, while the examining attorney agrees that there are substantial differences between a fatal accident and a nearly fatal accident, the marks in question are not identifying types of accidents. Instead they are used to identify articles of clothing. Because the term NEAR FATAL is arbitrary when used in conjunction with clothing, it is a "strong" mark and must be granted a relatively broad scope of protection.

In addition, the Examining Attorney asserts that the absence from applicant's "FATAL" mark of the term "NEAR" in registrant's "NEAR FATAL" mark "is insufficient to overcome a likelihood of confusion under Section 2(d) because "the deleted wording is not a dominant element of the mark." The Examining Attorney maintains, instead, that the dominant portion of registrant's mark is the word "FATAL" inasmuch as the word "NEAR" "is merely an adverb which modifies the term FATAL, and has no separate commercial impression." With respect to applicant's mark, the Examining Attorney insists that the "design element ... is undistinguished, and has little, if any commercial value" and that it is the word "FATAL" which "is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods ...."

When the marks at issue are considered in their entirety, we agree with the Examining Attorney that the contemporaneous use thereof in connection with closely related items of clothing is likely to cause confusion. The shared

presence of the word "FATAL" in applicant's stylized "FATAL" mark and in registrant's "NEAR FATAL" mark results in marks which are substantially similar overall in sound, appearance, connotation and commercial impression. The rectangular design in applicant's mark is clearly subordinate matter inasmuch as it serves simply as a background for the display of the term "FATAL," which as the sole literal element in the mark would be used by consumers and prospective customers in asking about applicant's ladies' hosiery and underwear. See, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). The stylization of such term, moreover, fails to distinguish applicant's mark since the typed drawing format in which registrant's "NEAR FATAL" mark is registered encompasses the display of such mark in any reasonable manner, including the same lower case lettering and font style as used by applicant for its mark. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) and INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). Furthermore, while lacking the rectangular background of applicant's mark, in actual use registrant's mark could certainly be depicted in the same or a similar fashion, such as a display on a dark-colored background. In terms of sound and appearance, therefore, the respective marks are substantially similar in their entireties.

With respect to connotation and commercial impression, it is true, as the Examining Attorney concedes, that there is indeed a significant difference between something being "fatal" and it being only "near fatal," at least insofar as death is



concerned. However, when such arbitrary terms are used in connection with items of apparel instead of in the abstract, applicant's "FATAL" mark and registrant's "NEAR FATAL" mark are substantially similar in overall connotation and commercial impression.

We accordingly conclude that purchasers and potential customers, who are familiar or acquainted with registrant's "NEAR FATAL" mark for its T-shirts, sweatshirts, jerseys, hats and shorts, would be likely to believe, upon encountering applicant's substantially similar stylized "FATAL" mark for its ladies' underwear and hosiery, that such closely related items of clothing emanate from, or are sponsored by or associated with, the same source. Furthermore, even assuming that such consumers would notice the difference in the respective marks, it would still be reasonable for them to believe, for example, that applicant's stylized "FATAL" mark for its ladies' underwear and hosiery designates a new or additional product line emanating from, or sponsored by, the same source as the T-shirts and various other outerwear garments offered by registrant under its "NEAR FATAL" mark.

**Decision:** The refusal under Section 2(d) is affirmed.